

Docket No.: 60,130-569

REMARKS

Appellant has now amended claim 19 to attend to a clear 35 U.S.C. § 112 ambiguity.

The rejection of all claims is improper. Claim 1 requires that a plurality of electrical components be actuated in response to a signal from a remote transmitter. The claim further requires the step of visually inspecting the actuation of the components from the location of the remote transmitter. Claim 10 requires an actuation sequence of electrical components in response to the signal from the transmitter, and the diagnostic analysis be performed upon the electrical components by actuating the electrical components with the remote transmitter. Claim 15 requires that a receiver on a vehicle receive an actuation signal from a remote transmitter, the receiver relaying an actuation signal to a plurality of electrical components to be actuated for diagnostic purposes and to allow visual inspection of the actuation of the components from the location of the remote transmitter.

The Examiner rejects all of these claims over the Doyle et al. patent. Doyle, et al., however, discloses no diagnostic information with regard to components on a vehicle. Instead, Doyle, et al. will transmit diagnostic information about the transmitter (not electrical components on a vehicle). As such, Doyle cannot properly anticipate any of the claims.

The Examiner next proposes to modify Doyle, et al. with either the Ostermann, et al. or Wallace patents. However, what is missing in Doyle, et al. is not supplied by Ostermann or Wallace. Simply, Doyle, et al. does not perform diagnostic information on vehicle components, rather simply transmitting diagnostic information with regard to the transmitter. Ostermann, et al. or Wallace do not overcome this deficiency in Doyle, et al.

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The Examiner's rejection of the claims 19-21 over Doyle, et al. taken with Traub is particularly improper. Doyle, et al. does not simply "not explicitly disclose the testing brakes." Instead, Doyle, et al. does not test anything on a vehicle. Appellant does not claim to have invented the concept of testing brakes or lights, but rather doing so with the remote transmitter. Nothing in Doyle, et al. or Traub would suggest this. Further, nothing in Traub would suggest any modification to Doyle, et al.

The Examiner takes the position that Appellant's argument is solely that Doyle does not disclose visual inspection. The Examiner appears to take the position that since Doyle does discuss some visual display, visual inspection is provided. However, what Doyle et al. disclose is diagnostic information with regard to the transmitter, not components on the vehicle, which is what the claims require be visually inspected.

Further, the Examiner makes reference to two cases to support an argument that an apparatus claim must be "structurally distinguishable" from the prior art. Appellant assumes that this argument applies to the apparatus claims 15, 17, 18 and 21. The other claims are of course method claims. The *Hewlett-Packard Co.* case does not relate to the issue. In the *Hewlett-Packard Co.* case an accused infringer was arguing that a claim was not patentable since there was no functional difference between the claim structure and the prior art structure. There were structural differences. The Federal Circuit merely made the unremarkable observation that those structural differences can be patentable. There is no support in this case for the position the Examiner tries to take here, that functional statements can be ignored in an apparatus claim. Instead, the holding was the opposite.


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In re Danley case (1959) is from before the decision in *Graham v. John Deere* in 1964. It has little or any relevance to a modern obviousness determination. The claims do specifically require a control which is structured and designed to provide certain functional benefits. A computer control such as claimed is an item which was not even in existence in 1959. A computer control is "structured" to include software, or circuitry, to achieve certain functions. That is, more than a function is claimed. *In re Danley* does not apply. This is the way the claim is written, this is the way the claim must be interpreted, and this is why the rejection is improper.

Appellant has now appealed this application, and had the application withdrawn from appeal for the Examiner to make a new rejection. The new rejection still does not address the issues. Appellant is now proceeding with another Notice of Appeal, and will presumably have to file another brief in the near future. Appellant asks that the Examiner carefully review the arguments above, and ensure that the Examiner is willing to proceed to appeal this time before burdening Appellant the cost of another Appeal.

The rejection is simply improper and should be withdrawn, and Appellant urges the Examiner to do so.

Respectfully submitted,


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CERTIFICATE OF MAILING

I hereby certify that the enclosed Amendment is being deposited with the United States Postal Service as first-class mail, postage prepaid, in an envelope addressed to Box AF, Assistant Commissioner of Patents and Trademarks, Washington, D.C. 20231, on this 12th day of November, 2001.


Tracey Belanger

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APPENDIX A

19. (Amended) A[n apparatus] method as set forth in Claim 1, wherein said plurality of electrical components includes at least the brake and at least some lights.